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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/814,402

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Jaspreet Singh

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,402

Applicant(s)

SINGH ET AL.

Examiner

Jacqueline F. Stephens

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-45 and 48-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-45, 48-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

The indicated allowability of claims 15, 16, 34 and 54 is withdrawn in view of Assarson and Veith. Rejections based on the newly cited reference(s) follow.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/2/05 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-7, 10-14, 17-38, and 55-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims set forth the physical characteristics desired of the composite alone rather than the specific composition of the composite in the end product. Therefore, relying on Ex parte Slob,

157 USPQ 172, such claims could cover any conceivable combination of materials whether presently existing or which might be discovered in the future and which would impart the desired characteristic, i.e. the claims are too broad and indefinite since they purport to cover everything having the claimed characteristics regardless of its composition (It should be noted that 35 USC 101 sets forth "Whoever invents or discovers any new and useful... composition of matter... may obtain a patent therefor... title, i.e. does not include composition that have yet to be invented and discovered.).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 15-45, 48-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Veith USPN 5516569.

As to claims 15-17, 19, 20, 22-24, 30-35, 37, 53, and 54, Veith discloses a web comprising fibers and superabsorbent material, wherein the web comprises a superabsorbent material content of at least about 60% (Veith col. 2, lines 5-9). The superabsorbent of Veith bonds with the fibers in the web. (col. 5, lines 38-48). Veith discloses combinations of superabsorbent in the web (col. 3, lines 16-51).

The limitation of the removal of liquid is directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

The Shakeout Test is determined by performing a test set forth in the application. Therefore the claims also define the invention by processes of manufacture, which require tests used to determine the test characteristics, and thus, the claims are product by process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claims 18, 21, 25, 29, 36, and 38 Veith discloses an absorbent article comprising the web (Veith col. 8 lines 27-32).

As to claim 39, a web comprising fibers and at least one superabsorbent material at least partially coated with the fibers, wherein individual bodies of the superabsorbent material have bonds with each other, with fibers that are coated upon other bodies of the superabsorbent material, or with a combination thereof, and the superabsorbent material comprises a composition that forms such bonds upon removal of a liquid contained in the superabsorbent material', wherein the bonds can form upon removal from the superabsorbent material of at least about 0.5 grams of the liquid per gram of superabsorbent material (Veith col. 2 lines 5-34).

As to claim 40, Veith discloses an absorbent article comprising the web of Claim 39. (Veith col. 2 lines 27-32).

As to claims 41-43, 49, and 50, these limitations are directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 44, see col. 4, lines 43-48.

As to claim 45, Veith does not disclose the liquid comprises distilled water.

However, it would be obvious to one skilled in the art at the time the invention was made to use distilled water since distilled water is commonly used in laboratories and in processing in manufacture.

As to claim 48, see col. 2, lines 60-67.

As to claim 51, see col. 5, lines 10-15.

As to claim 52, see col. 3, lines 51-52.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-7, 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Assarsson USPN 3901236 in view of Oczkowski USPN 4354487.

As to claim 1, Assarsson discloses a web comprising superabsorbent material and fibers wherein at least some of the fibers are coated onto the superabsorbent material prior to formation of the web (See for example Assarsson col. 4 lines 49-50., col. 5 lines 41-44, the web is formed while the superabsorbent material contains a liquid that it has absorbed (Assarsson col. 5 lines 47-49 wherein swelling hydrogen indicates absorbency), and at least some of the liquid absorbed in the superabsorbent is material is removed after formation of the web (Assarsson col. 8 lines 66-68).

The limitation of the web formation is directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

The Shakeout Test is determined by performing a test set forth in the application. Therefore the claims also define the invention by processes of manufacture, which require tests used to determine the test characteristics, and thus, the claims are product by process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 2, Assarsson discloses an absorbent article comprising the web of claim 1 (Assarsson col. 7 lines 62-68).

As to claims 3-5, 11 and 12, these limitations are directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 6, Assarsson discloses the liquid is selected from solutions that comprise water (col. 5, lines 47-49).

As to claim 7, Assarsson discloses the liquid is aqueous (col. 5, lines 47-49), but does not disclose the liquid comprises distilled water. However, it would be obvious to one skilled in the art at the time the invention was made to use distilled water since distilled water is commonly used in laboratories and in processing in manufacture.

As to claim 10, Assarsson discloses a web according to Claim 1, wherein the fibers comprise wood pulp fibers (col. 4 lines 29-39).

As to claim 13, Assarsson discloses the web comprises one or more fibers, particles, materials or combinations thereof in addition to the fiber and the superabsorbent material (col. 4 lines 13-46 disclosing mixtures of polymers, fibers and combinations', col. 7 lines 9-19 disclosing additives).

As to claim 14, Assarsson discloses the superabsorbent material comprises particles (col. 4, lines 24-28).

9. Claims 55-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Veith USPN 5516569.

As to claims 55, Veith discloses a web comprising fibers and superabsorbent material, wherein the web comprises a superabsorbent material content of at least about 60% (Veith col. 2, lines 5-9). Veith does not disclose a content of at least 90%. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the claimed superabsorbent content, since where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. The Shakeout Test is determined by performing a test set forth in the application. Therefore the claims also define the invention by processes of manufacture, which require tests used to determine the test characteristics, and thus, the claims are product by process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 56, Veith discloses an absorbent article comprising the web (Veith col. 8 lines 27-32).

As to claim 57, see col. 4, lines 43-48.

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As to claim 58, Veith does not disclose the liquid comprises distilled water.

However, it would be obvious to one skilled in the art at the time the invention was made to use distilled water since distilled water is commonly used in laboratories and in processing in manufacture.

As to claim 59, see col. 2, lines 60-67.

As to claims 60 and 61, these limitations are directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 62, see col. 5, lines 10-15.


As to claim 63, see col. 3, lines 51-52.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jacqueline F. Stephens
Examiner
Art Unit 3761

June 27, 2005